

REMARKS

SUMMARY:

The subject application sets forth claims 1-32, of which claims 1-20 have been canceled, and of claims 21 – 32, claims 21 and 27 are independent claims.

The detailed action dated July 28, 2005 set forth several characterizations of the subject application. Such Office Action alleges that claims 21-32 are directed to non-statutory subject matter and stand rejected under 35 U.S.C. §101. Previously presented claims 21 – 32 further stand rejected under 35 U.S.C. §103(a) as being allegedly obvious over U.S. Patent No. 5,911,069 ([Beard](#)) in view of “admitted prior art” and U.S. Patent No. 6,363,522 ([Click](#)).

Responses to each of the characterizations outlined above, including a traversal of each technical and prior art rejection, will follow in order as presented by the Examiner in the July 28, 2005 Office Action.

REJECTION UNDER 35 U.S.C. §101:

The Examiner is of the opinion that the language of independent claims 21 and 27 “... raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete and tangible result ...” and, therefore, the claims do not “... form the basis of statutory subject matter under 35 U.S.C. 101.”

Applicants respectfully disagree with the Examiner’s allegation and point out that claims 21-32 are directed to (in independent claim 21) “A method for providing exception handling for a computer program, said method comprising the steps of ...” and (in independent claim 27) “A system for providing exception handling for a computer program, comprising”

35 U.S.C. 112, sixth paragraph, clearly provides a sound statutory basis for such claim formats. Moreover, the statute clearly states that when applicants, as here, avail themselves of such a permissible claim format, the “... **claim shall be construed to**

cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” (emphasis added)

Applicants have disclosed, for example, at page 4 lines 12-13 of their current specification, that “... it should also be noted that ... the preferred embodiment of the invention describes functionality provided by a server computer.” Moreover, Applicants have stated at page 4, lines 15 - 22 that:

An example of a general-purpose computer that can implement the exception handling system of the present invention is shown in FIG. 2. The exception handling system 50 of the invention can be implemented in software (e.g. firmware), hardware, or a combination thereof. In one embodiment, the exception handling system 50 is implemented in software, as an executable program, and is executed by special or general purpose digital computer, such as a personal computer (PC; IBM-compatible, Apple-compatible, or otherwise), workstation, minicomputer, personal digital assistant (PDA) or mainframe computer.

Contrary to the Examiner's allegation that such “... does not recite a limitation in the technological arts” it is believed that not only are such computers and microprocessors a part of the “technological arts,” they are indeed part of the forefront of the technological arts. Because Applicants have chosen to avail themselves of a statutorily sanctioned claim format, Applicants, in fact are not claiming mental processes, or writing something on a piece of paper but rather have disclosed specific elements clearly within the technological arts and have made claims to subject matter corresponding to that disclosure in a form that is clearly approved and very commonly used to provide appropriate protection for a disclosed invention.

The Examiner states further that: Independent claims 21 and 27 do not appear to require any computer hardware to implement the claimed invention.” Applicants strongly believes that the previously mentioned arguments more than satisfy all requirements under 35 U.S.C. 101 as to patentable subject matter, however, Applicants

also note that the independent claims *per se* recite in claim 21 "...establishing a plurality of classes of exception types, said plurality of exception types including application exceptions, system exceptions and validation exceptions..." and in claim 27 "...an exception determination mechanism that identifies an exception type for an exception using the exception dictionary, wherein the identified exception type is one of an application exception, a system exception and a validation exception..." (emphasis supplied). Moreover, claim 21 recites "...providing an exception dictionary..." while claim 27 recites "A system ... comprising ... an exception dictionary used to list instances of each exception type..." (emphasis supplied).

Applicants respectfully submit that the claims at least clearly encompass "systems" including an "exception dictionary" and neither one of these useful, concrete and tangible elements can be properly passed off as an "abstract idea that is not tied to a technological art."

Futhermore, to the extent that the present subject matter specifically involves processes, Applicant further notes in accordance with guidelines set forth in §2106 (IV)(B)(2)(ii) of the MPEP, that a computer-related process limited to a practical application in the technological arts should be considered as statutory. Also, a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e., the method recites a step or act of producing something concrete and tangible. See, for example, AT&T Corp. v. Excel Communications Inc., 172 F3d 1352,1358, 50 USPQ2d 1447,1452 (Fed.Cir.1999); cert.denied, 528 US 946.

Applicants also note with interest the Examiner's own comments made with respect to the rejection under 35 U.S.C. 103(a) at page 5 of the outstanding office action that: "As to claims 27-32, these are the system claims corresponding to claims 21-26..." Apparently the Examiner does recognize that the present invention involves a "system" and is thus more than simply an "abstract idea."

In light of the above remarks, Applicants specifically request reconsideration of this ground of rejection.

REJECTION UNDER 35 U.S.C. §103(a):

Previously presented claims 21-32 stand rejected under 35 U.S.C. §103(a) as allegedly obvious over U.S. Patent No. 5,911,069 (Beard) in view of “author admitted prior art” and U.S. Patent No. 6,363,522 (Click). Based on the following remarks, Applicant respectfully requests reconsideration of such USPTO positions on alleged obviousness.

Before setting forth a discussion of the prior art as it is now applied in the subject Office Action, it is respectfully submitted that controlling case law has frequently addressed rejections under Section 103, for example, as follows.

In addition to the well-known required multi-step analysis of Graham v. John Deere Co., 381 U.S. 1, 148 U.S.P.Q. 459 (S. Ct. 1966), and its progeny, the Court of Appeals for the Federal Circuit has on numerous occasions offered its guidance concerning the propriety of Section 103 rejections.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. (emphasis original)

ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

The task of the Patent Office is essentially a burden of proof not just to show prior patents with selected elements similar to respective parts of a claimed combination, but to show teachings to support obviously combining the elements in the manner claimed.

Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, ' 103.

Panduit Corp. v. Dennison Manufacturing Co., 1 U.S.P.Q. 2d 1593, 1603 (Fed. Cir. 1987; footnotes omitted).

In In re Deminski, 230 U.S.P.Q. 313 (Fed. Cir. 1986), the court reversed a Patent Office Board of Appeals decision rejecting claims for obviousness, saying: "There [was] nothing in the prior art references, singly or in combination, 'to suggest the desirability, and thus the obviousness' of the [claimed subject matter]." Id. at 315; emphasis original. The court noted that the relied-on reference did not address the technical problem addressed by the claimed invention (and in fact taught away from the Applicant's invention), and stated the well-established principle that "[h]indsight analysis is clearly improper. . . ." Id. at 316.

In Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 U.S.P.Q. 416 (Fed. Cir. 1986), the court vacated a district court holding of invalidity for obviousness. In doing so, the district court was criticized for viewing teachings from the prior art in isolation, instead of considering the prior art references in their entirety; for entering the tempting but forbidden zone of hindsight analysis; for failing to view the claimed invention as a whole; and for disregarding express claim limitations. Id. at 419, 420.

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.

Bausch & Lomb, supra, at 419 (emphasis added).

The Supreme Court in Graham and Adams . . . foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness must be supported by facts. [footnote omitted]
Where the legal conclusion is not supported by facts, it cannot stand. . . .

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . It [the Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. . . . [W]e may not

resolve doubts in favor of the Patent Office determination when there are deficiencies in the record as to the necessary factual bases supporting its legal conclusion of obviousness.

In re Warner, 379 F.2d 1011, ___, 154 U.S.P.Q. 173, 177, 178 (C.C.P.A. 1967; emphasis original).

"[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness." Ex parte Clapp, 227 U.S.P.Q. 972, 973 (PTO Bd. App. 1985).

In addition, for example, in In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), a Section 103 rejection previously approved by the Board of Patent Appeals and Interferences was reversed by the Court of Appeals for the Federal Circuit. An apparatus claim recited, in essence, a means having a pumping capacity greater than an ingredient feed rate to a mixing chamber, while the reference disclosed a variable speed arrangement merely capable of the claimed operation but not expressly suggestive thereof.

While [the prior art] apparatus may be capable of being modified to run the way [applicant's] apparatus is claimed, there must be a suggestion or motivation in the reference to do so. [Citing authority] . . . The apparatus claimed by [applicant] is different from that of [the prior art reference]

. . . It is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure.

In re Mills, 16 U.S.P.Q.2d 1432, 1433.

"An analysis of obviousness of a claimed combination must include consideration of the results achieved by the combination. [Quoting authority] 'Critical to the analysis is an understanding of the particular results achieved by the new combination. . . .'" The Gillette Co. v. S.C. Johnson & Sons, Inc., 919 F.2d 720, ___, 16 U.S.P.Q.2d 1923, 1928 (Fed. Cir. 1990; affirming federal district court judgment holding claims not invalid).

The following analysis of the present rejections is respectfully offered with

guidance from the foregoing controlling case law decisions.

Rejection Under 35 U.S.C. §103(a) as allegedly obvious over U.S. Patent No. 5,911,069 (Beard) in view of “author admitted prior art” and U.S. Patent No. 6,363,522 (Click):

Previously presented claims 21-32 are directed to respective methods and systems for providing exception handling for a computer program. Since advanced computing and networking environments may result in exceptions/errors occurring in many various locations throughout a computer program, it is an advantage of the present technology to handle all such exceptions regardless of where they may occur.

As has been previously pointed out, Beard discloses features for characterizing exceptions for a specific environment limited to employing a System Object Model (SOM) method. Programs based on SOM techniques employ a mechanism in which the calling object, rather than the called method, detects and handles the exception. The features and steps disclosed in Beard are utilized only for this particular type of method, and not for an entire computer program which may often include many different methods and possible types thereof.

As is clear from an inspection of Beard's claimed invention, his subject matter is directed to methods for handling exceptions, computer programs for handling exceptions, and computer-readable storage mediums containing programs for handling exceptions all with the goal of handling exceptions using a first programming language program for handling exceptions which occur during a method carried out via a program carried out in a second programming language.

The present Office Action recognizes that: “Beard does not teach (1) that the plurality of exception types include application exceptions, system exceptions and validation exceptions, (2) providing an exception dictionary used to list instances of each exception type, and (3) that the identification uses the exception dictionary, wherein the identified exception type is one of an application exception, a system exception and a validation exception.” In an effort to cure these deficiencies, the

Examiner cites “author admitted prior art” (APA) which is alleged to teach the components under point (1) and Click which is alleged to teach the components under points (2) and (3).

Applicants definitively agree with the Examiner’s assessments regarding Beard's deficiencies; however, Applicants take strong exception to the Examiner’s allegations that the additionally cited references provide proper foundation and motivation for modifying Beard in order to arrive at the presently claimed method and system. The Examiner argues at page 4 of the present Office Action that: “One of ordinary skill in the art would have been motivated to combine the teachings of Bear (sic) and APA because this would have allowed the exception handling in a network environment.” Respectfully, Beard already provides for exception handling in a network. See, for example, his Fig. 1 and his discussion at column 9, lines 53-67.

Thus, Applicants submit, there would be no motivation at all to add a feature already present by combining alleged teachings from another reference (APA).

Beard is concerned with handling exceptions using a program written in one language generated by a program written in another language. **The real issue is not whether one may select APA or any other reference that may or may not actually disclose a particular feature, but rather whether a person of ordinary skill in the art having two references before them would be motivated to make any changes or additions to one of the references in light of the teachings of the other reference.**

In this particular instance, because Beard already discloses operation within a network environment, no additional functions or structure need to be supplied from APA or any other source to allegedly provide such feature already present.

Even assuming, *arguendo*, that Beard can be combined with APA, there would be no reason to add such features to Beard. The very purpose of Applicants’ disclosure is to offer alternative techniques for overcoming problems recognized in APA, which has been cited by the Examiner as motivation to modify Beard. Applicants respectfully point out that one of ordinary skill in the art would not be motivated to recreate that which Applicants have developed and claimed by reinserting those

problems that Applicants have identified in APA into any reference, including Beard.

With respect to points (2) and (3) mentioned by the Examiner as missing in Beard but provided by Click: Beard teaches at column 3, lines 7-15, that:

If an exception occurs during the execution of a method outside of the interpreted program, such as in a System Object Model (SOM) program (a language-neutral object model developed by IBM), it is labeled to identify its type. This label is used to identify a class within the interpreted program corresponding to the SOM exception. An instance of this class is allocated, and the exception data is copied into the object, which can then be used to generate an exception within the program.

Click has been cited for its alleged teaching of an exception dictionary used to list instances of each exception type. The Examiner appears to be of the opinion that disclosure by Click of an exceptions dictionary containing particular exceptions would motivate one of ordinary skill in the art to add such a feature to Beard. Applicants respectfully point out that, in light of the disclosure from Beard quoted above, Beard is not concerned with types of exceptions that may arise, but rather provides corrective measures "if an exception occurs during the execution of a method outside of the interpreted program."

Beard's exception handling methodology recognizes that an exception has occurred and provides a label for the exception type. Simply put, Beard really doesn't care what the exception type may be. Again then, the issue is not whether a reference, in this case Click, may be bodily incorporated into another reference or otherwise combined with the reference, but rather **whether there is proper motivation to one of ordinary skill in the art to actually make the combination**. Moreover, a major principle in actually combining references is that the combination should not destroy the operation of the primary reference. In this particular case Applicants respectfully suggest that adding an exceptions dictionary which lists specific exception types to a system that really doesn't care what the exception types may be and, moreover, provides its own labels for whatever type of exception may occur, would not constitute proper motivation to combine under 35 U.S.C. 103.

Based on the above remarks concerning claims 21 and 27, such claims should be allowed. Since claims 22-26 and 28-32 variously depend from such respective independent claims and further limit such claims, claims 22-26 and 28-32 should also be allowed.

CONCLUSION:

In light of the foregoing and for at least the reasons set forth above, Applicants respectfully submit that the present application, including claims 21-32, is in complete condition for issuance of a formal Notice of Allowance, and action to such effect is earnestly solicited. The Examiner is invited to telephone the undersigned at his convenience should only minor issues remain after consideration of this response in order to permit early resolution of same.

Respectfully submitted,

DORITY & MANNING,
ATTORNEYS AT LAW, P.A.

Date: December 28, 2005

A handwritten signature in black ink, appearing to read "Richard M. Moose", is written over a horizontal line.

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